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By: \_\_\_\_\_

AF/ 3738  
#36/85 PATENT  
Attorney Docket No. 16683-1-2

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

GERALD BLATT

Application No. 09/289,000

Filed: February 25, 1997

For: JOINT TREATING METHOD

Examiner: P. Prebilio

Art Unit: 3738

APPELLANT'S REPLY BRIEF  
TO EXAMINER'S ANSWER  
UNDER 37 CFR §1.192(a)

San Francisco, CA 94111  
March 13, 2003

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This Reply Brief is in response to the Examiner's Answer dated January 14, 2003.

I. Correction of Appellant's Brief

Upon a review of Appellant's Brief, an error was noted on page 13, line 8, where the word "subjective" should be replaced by the word --objective--. Thus, the sentence spanning lines 8 and 9 of page 13 of Appellant's Brief should read as follows:

The *objective* actual proof was provided by the two Rule 132 Declarations on file, sound technical understanding as embodied in Fig. A above, and logic.

II. Reply to Examiner's Response to Argument

The sentence bridging pages 5 and 6 of the Examiner's Answer asserts:

Furthermore, contrary to the manner depicted by Appellant's Figures A1, A2, and A3, "a tight fit between the holes and implant shafts is not required."

Noted  
PP  
03/31/03


The Cohen patent nowhere states that a tight fit between the holes and implant shafts is not required. It does state that "implant 70 is fit into *reamed* holes 62" (column 4, line 15). Holes are typically reamed in order to accurately size them, for example for purposes of establishing a tight fit. If no tight fit is required, reaming is not normally necessary. Thus, to the extent Cohen's disclosure contains any suggestion concerning the fit of the stem in the hole in the bone, it suggests the opposite of what is stated in the Examiner's answer, namely that there is a tight fit, and certainly not a loose fit, between the implant and the reamed hole.

The last paragraph on page 9 and the first paragraph on page 10 of the Examiner's Answer state that the "Examiner posits that some joint motion is admitted by declarant ...." and that "the Smith declaration provides some evidence that motion does occur when fibrous tissue grows between bone ends of a toe joint ...."

No such admission is in the Rule 132 declarations. More importantly, the claims are not limited to "some motion". The claims on appeal all require "relative slidable motion between the face [of the implant] and the cancellous bone surface" (claim 1) or language similar thereto. This is not "some motion", or any motion, but a specific motion which is impossible to attain with the implant of Cohen for the reasons discussed in Appellant's Brief.

For the reasons discussed in detail in Appellant's Brief, Appellant requests that the rejection of all claims be reversed.

Respectfully submitted,



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